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| EXAMINER |
|---|
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| ART UNIT | PAPER NUMBER |
|---|---|
| 2176 | |

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/805,575 | VASSMER ET AL. |
| | Examiner | Art Unit | |
| | Nathan Hillery | 2176 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *26 June 2006*.

2a)☒ This action is **FINAL**.  2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

**DETAILED ACTION**

1. This action is responsive to communications: Amendment filed on 6/26/06.

2. Claims 1 – 15 are pending in the case. Claims 1, 12 and 13 independent.

*Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1 – 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 – 11 and 13 – 15 do not produce a useful or tangible result. To be tangible the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. For example, merely assembling a new set of preexisting tags for presentation without creating a new set or anything else new (Specification, pp 10 and 11, paragraph block 0046), i.e. rearranging data or narrowing the amount of data without creating any data to be presented has been interpreted as just a thought or a computation within a processor and, thus, not tangible.

For an invention to be "useful" it must satisfy the utility requirement of 35 USC 101. The Office's official interpretation of the utility requirement provides that the utility of a claimed invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP 2107. Further, the disclosure may have met the requirements for utility, but what is claimed does not produce a result that reflects the disclosed utility or is too preliminary in and of itself to be a useful result. Even though an appropriate utility has been

disclosed, <u>the claims fall short of the disclosed practical utility</u>. In other words, the

claims fail to fulfill and/or reflect the specific, substantial, and credible utility sought by

the disclosed invention, thus not producing a useful result. Consequently, the claims are

nonstatutory.

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.      Claims 1 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Jammes et al. (US 6484149 B1) and further in view of Maynard (US 6484166 B1).

5.      **Regarding independent claim 13,**

Jammes et al. teach that *Then, in a step 506, the Initial_Event_Handler*

*formulates a query 312 designed to retrieve data representing all groups and products*

*contained in (i.e., subordinate to) the root level group My Store 320* (Column 16, lines

58 – 61), which meet the limitation of **a) presenting an initial set of descriptor tags**

**using an output device**. It should be noted that the Office has interpreted the data

representing the products of Jammes et al. to be synonymous with the claimed

**descriptor tags**, i.e. 3.360 and 3.362 of Figure 3 of Jammes et al.

Jammes et al. teach that *In a step 532 (FIG. 5), the right pane 309 of the store*

*design user interface 310 is displayed by a refresh method of the store management*

*control 306. The refresh method of the store management control 306 displays*

*information about products subordinate to a current group (i.e., a group represented by*

*an icon in the left pane 308 that is selected by a user) and also displays information*

*about groups subordinate to the current group* (Column 26, line 66 – Column 27, line 6),

and that *The Get_Subordinate_Groups routine returns, in one embodiment of the*

*present invention, a pointer to a linked list of group structures. Each group structure in*

*the linked list contains information about a group, including Group_ID value and*

*Group_Name value, and also includes a pointer to another group structure. The refresh*

*method of the store management control receives the pointer to this linked list of*

*structures and sequentially navigates the group structures. Navigation of the linked list*

*terminates when a pointer of a group structure is null* (Column 27, line 63 – Column 28,

line 5), which meet the limitation of **b) receiving an instruction to assemble a new set**

**of descriptor tags, the instruction being generated by a user using an input**

**device to select a structure tag, the instruction resulting in the generation of a**

**new set of information units, where the structure tag of the information units in**

**the new set are interconnected to the information units of a previous set; and c)**

**presenting the descriptor tags of the new set of the information units using the**

**output device.** It should be noted that the Office has interpreted the data representing

the group(s) of Jammes et al. to be synonymous with the claimed **structure tag**, i.e.

4.404 and 4.402 of Figure 4 of Jammes et al. It should also be noted that the Office has

interpreted the data representing the products of Jammes et al. to be synonymous with

the claimed **descriptor tags of the new set of the information units**, i.e. 4.412 of

Figure 4 of Jammes et al.

Jammes et al. teach that *In a further step 1614, a user repeats any of the steps*

*1602-1612 as needed to specify the inventory of an electronic store and to organize its*

*presentation* (Column 45, lines 3 – 6), which meet the limitation of **d) selectively**

**repeating steps b) and c) at the user's request**.

Jammes et al. do not explicitly teach **b) receiving an instruction to assemble a**

**new set of descriptor tags, the instruction being generated by a user using an**

**input device to select a _solution category tag_, the instruction resulting in the**

**generation of a new set of information units, where the _solution category tag_ of**

**the information units in the new set are interconnected to the information units of**

**a previous set**.

However, Maynard teaches that *a method for retrieving and displaying*

*information from at least one informational resource comprising the steps of: breaking*

*apart the at least one informational resource into a plurality of discrete finite elements;*

*creating a categorical tag for each of the plurality of discrete finite elements, the*

*categorical tag including a categorical designation pertaining to informational content*

*contained in the discrete finite element; generating a searchable database including a*

*searchable database record for each of the discrete finite elements; receiving a search*

*query; searching the searchable database for relevant database records that*

*correspond to the search query; associating the relevant database records with their*

*respective discrete finite elements; displaying identifying phrases pertaining to the*

*respective discrete finite elements of the relevant database records produced during the associating step; receiving an input selecting one of the displayed identifying phrases; reconstructing a contiguous portion of the informational resource around the selected discrete finite element by combining other discrete finite elements with the selected discrete finite element; and displaying said reconstructed contiguous portion* (Column 23, line 33 – Column 24, line 12), which meet the limitation of **b) receiving an instruction to assemble a new set of descriptor tags, the instruction being generated by a user using an input device to select one of a structure tag and a solution category tag, the instruction resulting in the generation of a new set of information units, where at least one of the structure and the solution category tags of the information units in the new set are interconnected to the information units of a previous set.**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Jammes et al. with that of Maynard because such a combination would allow the users of Jammes et al. the benefit of *an information management, retrieval and display system for searching through an informational resource, such as a document (e.g., a treaty), a number of individual documents (e.g., Web pages resident on the Internet), or a stream of information (e.g., DNA code, source code, satellite data transmissions, etc.) and for displaying the results of the search in an collapsible/expandable format based upon a user-selected display criteria or hierarchy* (Column 1, lines 48 – 56); in other words, a search based on categories of data.

6.    **Regarding independent claim 12,**

Jammes et al. teach that *the HTML authoring tool produces a template file (i.e., a simple ASCII text file), representing a template page. Each such template file includes HTML formatting codes (or tags), text content, and references to the product information database 116 which can be resolved to extract information about a group or product* (Column 42, lines 21 – 26), which meet the limitation of **an information item including information related to products; a descriptor tag indicating informational contents of said information item; and a structure tag pointing to at least one information unit in said data structure**. It should be noted that the Office has interpreted the *product ID* of Jammes et al. to be synonymous with the claimed **information related to products**, i.e. 3.360 of Fig 3 of Jammes et al.; *the data representing the group(s)* of Jammes et al. to be synonymous with the claimed **structure tag**, i.e. 4.404 of Fig 4 of Jammes et al.; and *the data representing the products* of Jammes et al. to be synonymous with the claimed **descriptor tag**, i.e. 4.412 of Fig 4.

Jammes et al. teach that *The Get_Subordinate_Groups routine returns, in one embodiment of the present invention, a pointer to a linked list of group structures. Each group structure in the linked list contains information about a group, including Group_ID value and Group_Name value, and also includes a pointer to another group structure. The refresh method of the store management control receives the pointer to this linked list of structures and sequentially navigates the group structures. Navigation of the linked list terminates when a pointer of a group structure is null* (Column 27, line 63 –

Column 28, line 5), which meet the limitation of **pointers interconnecting the**

**information item, the descriptor tag, and the structure tag to an information unit**

**based on user selection of an information unit from the plurality of information**

**units, wherein the pointers are used to output an information item related to one**

**of bearings and seals**.

Jammes et al. do not explicitly teach **a solution category tag pointing to at**

**least one information unit in the data structure;** and **pointers interconnecting the**

**information item, the descriptor tag,** _**the solution category tag**_ **and the structure**

**tag to an information unit**.

Maynard teaches that *the break module also creates categorical tags for each of*

*these finite elements, where the categorical tags assigned to each of the finite elements*

*are based upon and analysis (defined by the set of expert system rules) of the contents*

*of each of the finite elements. The categorical tag can include a standard classification*

*such as, for example, "Dewey Decimal-type" number. The categorical tag can also*

*include an organizational attribute (such as pertaining to the type or location of the finite*

*element with respect to the rest of the rest of the informational resource), a date-stamp,*

*a categorical word, etc. Preferably, the categorical tags are inserted into the finite*

*element* (Column 1, line 67 – Column 2, line 11) and that *each database record*

*preferably includes an address or pointer to the corresponding finite element and further*

*preferably includes all of the non-common strings (e.g., words or phrases) contained*

*within the corresponding finite element along with the frequency that such strings*

*appear* (Column 4, lines 54 – 58), which meet the limitation of **a solution category tag**

**pointing to at least one information unit in the data structure indicating membership of the information unit to a particular group; and pointers interconnecting the information item, the descriptor tag, the solution category tag and the structure tag to an information unit**. It should be noted that the Office has interpreted the *categorical tags* of Maynard to be synonymous with the claimed **solution category tag**.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the invention of Jammes et al. with that of Maynard because such a combination would allow the users of Jammes et al. the benefit of *an information management, retrieval and display system for searching through an informational resource, such as a document (e.g., a treaty), a number of individual documents (e.g., Web pages resident on the Internet), or a stream of information (e.g., DNA code, source code, satellite data transmissions, etc.) and for displaying the results of the search in an collapsible/expandable format based upon a user-selected display criteria or hierarchy* (Column 1, lines 48 – 56); in other words, a search based on categories of data.

Neither Jammes et al. nor Maynard explicitly teach **an information item including information related to _bearings_ and _seals_ or a solution category tag indicating membership of the information unit to _design_, _reliability_, _maintenance_ and _training_ categories**.

However these differences are only found in the nonfunctional descriptive material and do not affect the use and structural organization of the recited data structure. The use of "information items" including information relating to *particular*

products, e.g. bearings and seals, and a solution category tag that includes pointers

indicating membership of the information unit to a *particular* category, e.g. design,

reliability, maintenance, and training, would be performed the same regardless of the

particular products or categories. Similarly, the *particular* types of content within the

recited data structure have no effect on the structural organization of the data. Thus,

this descriptive material will not distinguish the claimed invention from the prior art in

terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404

(Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to **indicate membership of the information unit to any**

**type of category** and to have **an information item including information related to**

**any type of data or product**, because such data does not functionally relate to the

steps in the claim and because the subjective interpretation of the data does not

patentably distinguish the claimed invention.


7.    **Regarding independent claim 1**, the claim incorporates substantially similar

subject matter as claims 12 and 13, and is rejected along the same rationale.


8.    **Regarding dependent claim 2**, Jammes et al. teach that *FIG. 13 illustrates*

*fields and command buttons of a new group dialogue box 1301 which prompts a user*

*for information about a new group. The new group dialogue box 1301 includes a*

*merchant ID field 1302, a Group_ID field 1304, a Group_Name field 1306, a template*

*file field 1308, a description field 1310, and a small image field 1312. Also included in*

*the new group dialogue box 1301 are a `Cancel` button 1314 and an `Okay` button*

*1316* (Column 38, lines 10 – 17), which meet the limitation of **the descriptor tag of an**

**information unit is constituted by a portion of its information item**, and **the**

**descriptor tag of an information item is constituted by a description of the**

**contents of the information item.**

9.     **Regarding dependent claims 14 and 15**, the claims incorporate substantially

similar subject matter as claims 12 and 13, and are rejected along the same rationale.

10.    **Regarding dependent claim 4**, Jammes at al. teach that *in a preferred*

*embodiment, each product included in the right pane display is represented by one row*

*of text elements and each group included in the right pane display is represented by*

*one row comprising an icon and a text label* (Column 28, lines 20 – 23), which meet the

limitation of **the information item is comprised by at least one of the following**

**information types: text, photo, table and drawing.**

11.    **Regarding dependent claims 5 and 6**, Jammes et al. teach that *if, in the step*

*2014, the Web server determines that the consumer did not order a product, then, in a*

*next step 2018, the Web server 106 generates a database command designed to add a*

*new record to the browse table of the traffic analysis database. It will be understood*

*that such a database command accepts parameters representing values for the fields of*

*a new record of the browse table. To supply a value for the Consumer_ID field of the*

*new record, the Web server 106 access the consumer's cookie identifier and extracts*

*the unique Consumer_ID value. The Web server establishes a value for the*

*Template_File field of the new record by extracting a template file name from the URL*

*of the request message* (Column 51, lines 40 – 52), which meet the limitation of **the**

**initial set of descriptor tags is based on a cookie from a previous use session of**

**the computer program product**, and that **the initial set of descriptor tags is based**

**on a default set** (*template file(s)*).

12.     **Regarding dependent claims 7 – 11**, Jammes et al. teach that data records of a

product information database store information comprising an inventory of an electronic

store, including information about products and groups and the relationships between

them (Column 4, lines 22 – 25); that the enhanced Web browser 112 initiates data

transactions with the product information database 116. The enhanced Web browser

112 issues database transaction commands to the Web server 106, which in turn issues

those transaction commands to a relational database server 114. In a preferred

embodiment, the relational database server 114 utilizes open database connectivity

(ODBC). Relational database servers 114 utilizing ODBC are known in the art. One

function of such relational database servers is to provide to application programs a

common query interface to interact with multiple database systems having different

query interfaces (Column 8, lines 46 – 57); and that a web browser may be

implemented as a collection of instructions stored on computer storage media (e.g., disk

drive media, CD-ROM, ROM, EPROM, etc.), the instructions executable by a computer

as an application program, as part of the operating system, as a dedicated function of

network computer, or a combination of these or other forms for loading and executing

instructions (Column 6, lines 58 – 65), which meet the limitation of **the information unit**

**database is comprised in the computer program product**, that **the information**

**unlit structure database is comprised in the computer program product**, that **the**

**information unit database is integrated with the information unit structure**

**database**, that **intended to be used by a server connected to the Internet**, and that

**loaded on a carrier**.

### *Response to Arguments*

13.     Applicant's arguments filed 2/27/06 have been fully considered but they are not

persuasive.

14.     Regarding the rejection of claims 1 – 11 and 13 – 15 under 35 USC 101 for being

nonstatutory,

To satisfy section 101 requirements, the claim must be for a practical application

of the § 101 judicial exception, which can be identified in various ways:

The claimed invention "transforms" an article or physical object to a

different state or thing. The claimed invention otherwise produces a useful,

concrete and tangible result (Interim Guidelines for Examination of Patent

Applications for Patent Subject Matter Eligibility, p 19)


The Office maintains that the claims do neither.


Physical transformation occurs when the claimed invention transforms an article

or physical object to a different structural state or thing. Physical transformation is an

indication that the claim is statutory because such a transformation itself is a useful,

tangible and concrete result. However, data transformation is not a physical

transformation. Data, by definition, is intangible, so the claim must go further to have a

tangible result. Thus, manipulation of data in a computer is not, in and of itself,

sufficient for establishing that a claim is statutory. Likewise, a physical act is not

necessarily a physical transformation.

The next step in analysis involves determining whether the claims produce a

concrete, useful and tangible result.


Regarding a tangible result, the tangible requirement does not necessarily mean

that a claim must either be tied to a particular machine or apparatus or must operate to

change articles or materials to a different state or thing. However, the tangible

requirement does require that the claim must recite more than a § 101 judicial

exception, in that the process claim must set forth a practical application of that § 101

judicial exception to produce a real-world result (Interim Guidelines for Examination of

Patent Applications for Patent Subject Matter Eligibility, p 21).


Although the claims recite presenting data, the claims do not recite presenting

data to the user. The claims simply recite presenting data via an output means. Within

the broadest, reasonable interpretation in light of the specification, an output means

could simply mean the internal memory of a computer; that is to say presenting data to

be output to another application on the computer. Again manipulation of data in a

computer is not, in and of itself, sufficient for establishing that a claim is statutory.

Furthermore, no new data is created. Referring to the Specification and Figures 3

& 4, a new set of preexisting tags for presentation is merely assembled without creating

a new set or anything else new (Specification, pp 10 and 11, paragraph block 0046), i.e.

the data is rearranged and/or narrowed without creating any new data to be presented.

For example, if the computer already contains an initial set, the set of Integers, the

users selects only even, and then the computer assembles a new set, the set of Even

Integers, then the computer has simply reduced the amount of existing data. The data

that makes up the new set, the set of Even Integers, is not new; it is simply a subset of

the initial set, the set of Integers.


Regarding a useful result, the disclosure may have met the requirements for

utility, but what's claimed does not produce a result that reflects it or is too preliminary in

and of itself to be a useful result.  In this case, the claimed invention does not provide a

useful result even though an appropriate utility has been disclosed, and a rejection as non-statutory is appropriate.

Specifically, the Specification states that the purpose of the present invention is to alleviate the limitation above by suggesting an information structure system in the form of a computer program product that offers increased opportunities for finding requested information easy and swiftly. The information structure system according to the present invention presents improved opportunities of searching, by selecting among information units, for information concerning at least one of products, their use and technical solutions in relation to bearings and seals.

In addition, when the examiner has reason to believe that the claim is not for a practical application that produces a useful result, the claim should be rejected, thus requiring the applicant to distinguish the claim from the three § 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application. In such cases, statements in the specification describing a practical application may not be sufficient to satisfy the requirements for section 101 with respect to the claimed invention. Likewise, a claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application. In other words, if the specification discloses a practical application of a § 101 judicial exception, but the claim is broader than the disclosure such that it does not require a practical application, then the claim must be rejected (Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, p 21).

15.    Applicant argues that claim 1 incorporates several limitations that do not appear

in claims 12 and 13 (p 10, first full paragraph) because the Office does not address any

of the specific tags or the interconnection between them by the use of pointers.

The Office disagrees.

It should be noted that all of the "limitations" recited in the preamble of claim 1

are recited in the body of claim 12 and that all of the limitations recited in the body of

claim 1 are recited in the body of claim 13. Further, The Office fully addressed and

rejected claim 12, which recites the specific tags and the interconnection between them

by the use of pointers.


16.    Applicant argues that Jammes et al. is not directed towards bearings and seals

nor allowing a user who is a customer to select the information (p 10, second full

paragraph) because Jammes et al. is specifically directed to a store design user

interface.

The office disagrees.

It should be noted that the claims do not recite a customer and are thus not

limited to such functionality. Although neither Jammes et al. nor Maynard explicitly teach

**an information item including information related to one of bearings and seals,**

this difference is only found in the nonfunctional descriptive material and is not

functionally involved in the step recited. Processing "information items" would be

performed the same regardless of the data. Thus, this descriptive material will not

distinguish the claimed invention from the prior art in terms of patentability, see *In re*

*Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32

F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, the Office contends that no patentable weight is given to the

descriptive material, i.e. to have **an information item including information related to**

**any type of data or product**, because such data does not functionally relate to the step

in the claim and because the subjective interpretation of the data does not patentably

distinguish the claimed invention. The particular information does not materially effect

the outcome.

17.     Applicant argues that Jammes et al. do not explicitly state verbatim that the

product indicates information contents of the information item comprised within an

information unit as claimed (p 10, last paragraph).

The Office disagrees.

Although Jammes et al. do not explicity recite the same identical words of the

claims verbatim, it should be noted that the broadness of the claim language permit the

teachings of Jammes to meet the claimed language as explained above in the rejection

of the lcaim under 35 USC 103(a) above, since broad language can always be rejected

using narrow language.

18.     In response to Applicant's argument that Jammes et al. do not teach limitations b

and d (p 11).

The Office disagrees.

It should be noted that Jammes et al. do teach **b) receiving an instruction to assemble a new set of descriptor tags, the instruction being generated by a user using an input device to select one of a structure tag and a solution category tag, the instruction resulting in the generation of a new set of information units, where at least one of the structure and the solution tag of the information units in the new set are interconnected to the information units of a previous set**, since the phrases **select one of** and **at least one of** constitute open ended language requiring only one of a group. As explained in the rejection above, Jammes et al. teach a **structure tag** (Figure 4.402) and thus also teach limitation d), since Jammes et al. teach that *In a further step 1614, a user repeats any of the steps 1602-1612 as needed to specify the inventory of an electronic store and to organize its presentation* (Column 45, lines 3 – 6), which meet the limitation of **d) selectively repeating steps b) and c) at the user's request**.

Furthermore, the Office chooses to address **solution category tags** in the alternative to further expedite prosecution. The Office maintains that Jammes et al. do not explicitly teach **solution category tags**. However, as explained in the rejection above Maynard does teach **solution category tags**. It should be noted that the Office has interpreted the *categorical tags* of Maynard to be synonymous with the claimed **solution category tag**.

19.     In response to Applicant's argument that Maynard does not remedy the

deficiencies of Jammes et al. regarding solution category tags (p 12).

The Office disagrees.

It should be noted that although neither Jammes et al. nor Maynard explicitly

teach **indicating membership of the information unit to one of design, reliability,**

**maintenance and training categories**, this difference is only found in the

nonfunctional descriptive material and is not functionally involved in the step recited.

The use of a solution category tag would be performed the same regardless of the data.

Thus, this descriptive material will not distinguish the claimed invention from the prior art

in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404

(Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, the Office contends that no patentable weight is given to the

descriptive material, i.e. to **indicate membership of the information unit to any type**

**of category**, because such data does not functionally relate to the steps in the claim

and because the subjective interpretation of the data does not patentably distinguish the

claimed invention.


20.     In response to Applicant's argument that the combination of Jammes et al. and

Maynard does not teach **b) receiving an instruction to assemble a new set of**

**descriptor tags, the instruction being generated by a user using an input device**

**to select a solution category tag, the instruction resulting in the generation of a**

**new set of information units, where the solution category tag of the information**

**units in the new set are interconnected to the information units of a previous set,**

(pp 14 – 15).

The Office disagrees.

It should be noted that the Office maintains that Maynard generates categorical

tags for use with the invention of Jammes et al.

By Applicant's own admission,

> *the Maynard patent describes a system including a break module that*
>
> *parses through an information resource such as a document, a group of*
>
> *documents or a stream of information to create a number of "finite elements,"*
>
> *such as paragraphs, sections, sub-sections, and segments. Th. e break module*
>
> *also creates and assigns categorical tags for each of the finite elements based*
>
> *on a set of expert rules. Next, Maynard describes an "index module" that parses*
>
> *through the finite elements identified/created/ processed by the break module to*
>
> *create a searchable database of records, each record corresponding to one of*
>
> *the finite elements. Each of these records includes an address or location of the*
>
> *corresponding finite element, the categorical tag assigned to the finite element,*
>
> *and a string contained in the finite element and its frequency within the finite*
>
> *element (p 12, last paragraph).*

The Office maintains that the combination of Jammes et al. and Maynard would

be used by the skilled artisan at the time of the invention to meet the claim limitation of

b. The teachings of Maynard, e.g. generating categorical tags, combined with the

teachings of Jammes et al., e.g. creating a new group as depicted in Figure 13 and

selecting among those groups to display a new set of assembled items as depicted in

Figure 4.


21.     In response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art.  See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).  In this case, the motivation

came form the references themselves in that Jammes et al. teach that

> *Using the Merchant Workbench, the store designer uses a graphical user*
>
> *interface to create and edit product information, establish categories of products,*
>
> *and organize a navigable hierarchy of products and categories. The Merchant*
>
> *Workbench allows a merchant having little or no knowledge of HTML coding or*
>
> *database queries to design an electronic store wherein a collection of template*
>
> *Web pages is integrated with a product information database (or inventory*
>
> *control system) such that information is extracted on-demand from the database,*
>
> *merged with the Web page templates, and presented to consumers* (Column 3,
>
> lines 2 – 12).

Maynard teaches

> an information management, retrieval and display system for searching
>
> through an informational resource, such as a document (e.g., a treaty), a number
>
> of individual documents (e.g., _Web pages resident on the Internet_), or a stream of
>
> information (e.g., DNA code, source code, satellite data transmissions, etc.) and
>
> for displaying the results of the search in an collapsible/expandable format based
>
> upon a user-selected display criteria or hierarchy (Column 1, lines 48 – 56).

The Office maintains that one of ordinary skill in the art at the time of the

invention would have combined the teachings of Jammes et al. with that of Maynard

based at least in part for Web page processing.

22.    Applicant argues that Jammes et al. do not describe a descriptor tag indicating

informational contents of said information and a structure tag pointing to at least one

information unit in said data structure (p 17, first full paragraph).

The Office disagrees.

By applicant's own admission, Jammes et al. states that the HTML authoring tool

produces a template file representing a template page. Each template file includes

HTML formatting codes (or tags), text content, and references to a product information

database, which can be resolved to extract information about a group or product (p 17,

first full paragraph), which meet the limitation of a descriptor tag indicating informational

contents of said information and a structure tag pointing to at least one information unit

in said data structure, since the text content of Jammes et al. is synonymous to the informational contents and the references of Jammes et al. are synonymous to the structure tag pointing to an information unit.

23.    Applicant argues that Jammes et al. do not disclose a structure tag because the Office states that Jammes et al. do not explicitly teach pointers (p 17, last paragraph).

The Office disagrees.

It should be noted that the Office has never made the assertion that Jammes et al. do not teach pointers. On the contrary, Jammes et al. do explicitly teach pointers in that Jammes et al. explicitly that *the Get_Subordinate_Groups routine returns, a* **pointer** *to a linked list of group structures. Each group structure in the linked list contains* **information about a group,** *including Group_ID value and Group_Name value, and also includes* **a pointer to another group structure** (Column 27, line 63 – Column 28, line 5).

24.    Applicant argues that Maynard fails to meet the claim limitations because the solution category tags of the information unit exist prior to any search being performed as recited in the independent claims (p 18, first full paragraph).

The Office disagrees.

It should be noted that applicant is arguing features that are not claimed. The office can not find any recitation or requirement that the solution category tags of the information unit exist prior to any search being performed in any of the claims.

25.    In response to applicant's argument that neither Jammes et al. nor Maynard

disclose all the claimed elements of claim 12 (p 19).

The Office disagrees.

It should be noted that the Office has interpreted the *product ID* of Jammes et al.

to be synonymous with the claimed **information related to products**, i.e. 3.360 of Fig 3

of Jammes et al.; *the data representing the group(s)* of Jammes et al. to be

synonymous with the claimed **structure tag**, i.e. 4.404 of Fig 4 of Jammes et al.; and

*the data representing the products* of Jammes et al. to be synonymous with the claimed

**descriptor tag**, i.e. 4.412 of Fig 4.

The Office maintains that neither Jammes et al. nor Maynard explicitly teach **an**

**information item including information related to *bearings* and *seals* or a solution**

**category tag indicating membership of the information unit to *design*, *reliability*,**

***maintenance* and *training* categories**.

However these differences are only found in the nonfunctional descriptive

material and do not affect the use and structural organization of the recited data

structure. The use of "information items" including information relating to *particular*

products, e.g. bearings and seals, and a solution category tag that includes pointers

indicating membership of the information unit to a *particular* category, e.g. design,

reliability, maintenance, and training, would be performed the same regardless of the

particular products or categories. Similarly, the *particular* types of content within the

recited data structure have no effect on the structural organization of the data. Thus,

this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to **indicate membership of the information unit to any type of category** and to have **an information item including information related to any type of data or product**, because such data does not functionally relate to the steps in the claim and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

26.     In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation came form the references themselves in that Jammes et al. teach that

> *Using the Merchant Workbench, the store designer uses a graphical user interface to <u>create and edit product information, establish categories of products, and organize a navigable hierarchy of products and categories</u>. The Merchant Workbench allows a merchant having little or no knowledge of HTML coding or*

*database queries to design an electronic store wherein a collection of template*

*Web pages is integrated with a product information database (or inventory*

*control system) such that information is extracted on-demand from the database,*

*merged with the Web page templates, and presented to consumers* (Column 3,

lines 2 – 12).

Maynard teaches

*an information management, retrieval and display system for searching*

*through an informational resource, such as a document (e.g., a treaty), a number*

*of individual documents (e.g., Web pages resident on the Internet), or a stream of*

*information (e.g., DNA code, source code, satellite data transmissions, etc.) and*

*for displaying the results of the search in an collapsible/expandable format based*

*upon a user-selected display criteria or hierarchy* (Column 1, lines 48 – 56).

The Office maintains that one of ordinary skill in the art at the time of the

invention would have combined the teachings of Jammes et al. with that of Maynard

based at least in part for Web page processing.

### Conclusion

1.    Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Nathan Hillery whose telephone number is (571) 272-

4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NH

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